

Appl. No. 10/010,391
Atty. Docker No. 8384R
Reply Dated October 2, 2003
Reply to Office Action of July 2, 2003
Customer No. 27752

REMARKS/ARGUMENTS

Figures 1, 4, 5 and 6 have been amended to include the reference numeral 70 (cutting means) as requested in the Office Action.

Claim 5 has been amended to replace the term "can be". Furthermore, Claim 1 has been amended to include the limitations of Claim 3, which has been canceled without prejudice.

Claims 11 and 15 have been amended to better clarify the claims.

Claims 13 and 16 have been amended to make them dependent upon Claims 11 and 15 respectively.

Claims 3, 4 and 9 have been canceled without prejudice, Claims 10, 12, 17 and 19 have been withdrawn and Claims 1-2, 5-8, 11, 13-16, 18 and 20 remain pending in the present application. No claims and no new matter have been added, and no additional claim fee due. Entry of this Amendment is respectfully requested.

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OBJECTIONS

1) Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the reference numeral 70 mentioned in the description. Applicants are submitting a corrected set of figures which include the reference numeral 70.

The drawings are objected to under 37 CFR 1.83(a). The Office Action notes that the drawings must show every feature of the invention specified in the Claims and therefore must include a drawing(s) of the curved passage way of Claim 9. Applicants have canceled Claim 9 without prejudice thereby rendering the objection moot.

In view of the foregoing remarks, additional figures and the clarifying amendments, it is respectfully requested that the objections to the figures be reconsidered and withdrawn.

2) Claims

Claims 13 and 16 are objected to as Claim 13 and 16 are identical to each other and they are both dependences of Claim 1. Claims 13 and 16 have been amended to make them dependent upon Claims 11 and 15 respectively.

In view of the foregoing remarks, and amendments, it is respectfully requested that the objections to Claims 13 and 16 be reconsidered and withdrawn.

REJECTIONS

Rejections Under 35 U.S.C. §112

35 U.S.C. §112 Second Paragraph

1) Claims 3-5, 11, 15, 18 and 20

Claims 3-5, 11, 15, 18 and 20 have been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action noted that the phrase "can be" renders the scope of the claims indefinite.

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Applicants are amending Claim 5, the only rejected claim where the term "can be" appears in a pending claim. In Claim 5 the phrase "can be closed" has been replaced with the phrase "are closeable".

Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claims 3-5, 11, 15, 18 and 20 be reconsidered and withdrawn.

2) Claim 3

Claim 3 has been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action noted that the phrase "tubular sheet includes an adhesive" renders the scope of the claims indefinite.

Claim 3 has been canceled without prejudice thereby rendering the rejection of this claim moot. Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claim 3 be reconsidered and withdrawn.

3) Claim 4

Claim 4 has been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action noted that the phrase "separating means comprises a separable region within the tubular sheet" renders the scope of the claims indefinite.

Claim 4 has been canceled without prejudice thereby rendering the rejection of this claim moot. Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claim 4 be reconsidered and withdrawn.

4) Claim 9

Claim 9 has been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. Specifically, the Office Action noted that the phrase "the passage way is curved" renders the scope of the claims indefinite.

Claim 9 has been canceled without prejudice thereby rendering the rejection of this claim moot. Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claim 11 be reconsidered and withdrawn. 7

5) Claims 11 and 15

Claims 11 and 15 have been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action noted that the phrase "an adhesive disposed on at least one surface" renders the scope of the claims indefinite.

Applicants are amending Claims 11 and 15, and replacing the phrase "one surface" with the phrase "one of said surfaces". Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claims 11 and 15 be reconsidered and withdrawn.

Rejections Under 35 U.S.C. §102

Lecomte

Claims 1, 2, 4, 8, 9, 13 and 16 have been rejected under 35 U.S.C. §102(e) as being anticipated by Lecomte US Patent No 6,065,272. It is the Examiner's contention that that the claimed articles are anticipated by the disclosure of Lecomte. Applicants respectively traverse the rejection.

Applicants have amended Claim 1 to include the limitations of canceled Claim 3, which was never rejected under 35 U.S.C. §102(e) as being anticipated by Lecomte. Consequently, this amendment has rendered the rejection moot and Applicant respectfully request withdrawal of this rejection.

As to Claims 4 and 9, they have been canceled without prejudice thereby making the rejection of Claims 4 and 9 over Lecomte moot.

With respect to Claims 13 and 16, they have been amended to make them dependent upon Claims 11 and 15 respectively, both of which were never rejected

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under 35 U.S.C. §102(c) as being anticipated by Lecomte. Consequently, this amendment has rendered the rejection of Claims 13 and 16 moot and Applicant respectfully request withdrawal of this rejection.

In view of the foregoing remarks and the clarifying amendments, it is respectfully requested that rejection of Claim 1, 2, 4, 8, 9, 13 and 16 be reconsidered and withdrawn.

Rejection under 35 U.S.C. 103

1) Lecomte in view of Hamilton

Claims 3, 5-7, 11, 14 15, 18 and 20 are rejected under 35 U.S.C. §103 as being obvious over Lecomte, US Patent No. 6,065,272 in view of Hamilton et al., US Patent No. 5,662,758. It is asserted in the Office Action that the claimed device is obvious in light of what is taught by Lecomte in view of Hamilton. Applicants respectively traverse the rejection.

It is well known that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re Rouffet 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir.1998). Second, there must be a reasonable expectation of success. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); and In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP706.02(j); In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and MPEP Section 2143 - Section 2143.03.

Turning to the present rejection, it is clear that the Office Action has failed to establish a prima facie case of obviousness. For a start, one of ordinary skill would have no motivation to combine Lecomte with Hamilton.

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In Lecomte the invention is directed to the permanent heat-sealing of various types of waste in a heat-sealable plastic sleeve. See Lecomte Column 2, lines 10-13, Column 3, lines 23-25, 32-35, 43, 54-57, and 63-67 and Column 4, lines 10-11, 29-33, 29 and 44, Claim 1 and Figures 1 and 2. Contrast this with Hamilton which is specifically directed to a flexible film having a protected pressure sensitive adhesive thereon. See Hamilton, abstract Figures and Claims. The purpose of the protected pressure sensitive adhesive of Hamilton is for a product which is "releasably sealing to a target surface", Column 1, line 8, and "for releasable sealing of the composite material to such surfaces or even to itself", Column 3, lines 24-25 (Emphasis added). The adhesive is protected to prevent premature sealing by the adhesive on the film, especially to itself. And when the protrusions are collapsed the adhesive is available to form a seal with the desired surface.

However, this asserted advantage is of little relevance as the Office Action has failed to provide any suggestion, motivation or teaching as to why one of ordinary skill would even bother to include an adhesive with a film, let alone the specific film of Hamilton, and use it in the apparatus of Lecomte.

The apparatus of Lecomte "welds", a heat-sealable plastic sleeve to form a receptacle for receiving waste. Column 1, line 55-57 and Figure 1. Once the waste is placed in to this formed "receptacle" the heat-sealable plastic sleeve is then welded at the other end to form a closure. See Lecomte Column 3, lines 23-25, and Column 4, lines 10-11, 29-33, 29 and 44, Claim 1 and Figures 1 and 2. There is no need for an adhesive on the heat-sealable plastic sleeve, as the seal is formed by the "retractable heating pliers", Column 3, line 24 Figure 1 and Claim 1.

The Office Action has missed that one of ordinary skill in the art would realize that the benefits of Hamilton alleged in the Office Action are simply irrelevant. Hamilton allegedly solves problems associated with films containing adhesives, i.e. preventing the adhesive from inadvertent adherence to other surfaces. Since the "retractable heating pliers" are sealing the heat-sealable plastic sleeve there is no reason, motivation, suggestion, teaching or need for that matter to include an adhesive which would need to be "protected from inadvertent adherence to other surfaces". Hamilton is teaching one of ordinary skill away from any combination with Lecomte. Why include an adhesive, let alone the protected one of Hamilton,

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when not using an adhesive, such as Lecomte already does, avoids the entire issue of "inadvertent adherence to other surfaces" identified in the Office Action as a problem to be solved by one of Ordinary skill. One of ordinary skill would not consider Hamilton relevant let alone worthy of consideration for combination with Lecomte.

Furthermore, it is apparent that the rejection is applying the "obvious to try" standard which has been consistently held improper. It is well settled that the question of obviousness under 35 U.S.C. §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986), and In re Brouwer, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996). See also MPEP 2143.01; In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It is unclear as to why one of ordinary skill would consider the combination of Lecomte and Hamilton relevant. Furthermore, there is no teaching, motivation and/or suggestion to one of ordinary skill modify any possible combination of Lecomte and Hamilton and the only suggestion provided in the Office Action has been impermissible hindsight based on Applicants' own teaching.

Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claims 3, 5-7, 11, 14, 15, 18 and 20 be reconsidered and withdrawn.

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CONCLUSION

In light of the amendments and remarks presented herein, Applicants respectively submit that Claims 1-2, 5-8, 11, 13-16, 18 and 20 are allowable over the prior art of record or any combination thereof. In the event that issue remain prior to allowance of the noted claims, then the Examiner is invited to call Applicant's undersigned agent to discuss any remaining issues.

Respectfully submitted,

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Date: October 2, 2003

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